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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/214,277	03/01/1999	KENJI KAWADA	32-248P	8984

7590

07/14/2004

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 07/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/214,277	KAWADA ET AL.	
	Examiner	Art Unit	
	Venkataraman Balasubramanian	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34,35,37,40,42-49 and 52-67 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 34,35,37,40,45-49,52 and 55-67 is/are allowed.
- 6) ☒ Claim(s) 42-44,53 and 54 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/31/1998</u> . | 6) <input type="checkbox"/> Other: ____ |

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DETAILED ACTION

Applicants' response, which included cancellation of claims 28-33, 36, 50-51 and addition of new claims 60-67, filed on 4/27/2004 is made of record.

Claims 34-35, 37, 40, 42-49, 52-67 are now pending. In view of applicants response the following apply.

Information Disclosure Statement

References cited in the Information Disclosure Statement filed on 12/31/1998 are made of record.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The process claims 42-44 and 53-54 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for compound of formula I, wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 1 to 4, does not reasonably provide enablement for compound of formula I, wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 0. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims for reasons of record. To repeat:

In evaluating the enablement question, following factors are considered. Note In re Wands, 8 USPQ2d 1400 and Ex parte Forman, 230 USPQ 546. The factors include:

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1) The nature of the invention, 2) the state of the prior art, 3) the predictability or lack thereof in the art, 4) the amount of direction or guidance present, 5) the presence or absence of working examples, 6) the breadth of the claims, and 7) the quantity of experimentation needed.

1. The nature of the invention and the state of the prior art:

The invention is drawn to process of making variously substituted compound of formula I wherein A and Z in formula II or III are borinate groups, halogen or $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ where q is 0 to 4. But when q is 0, the choice of $\text{OSO}_2(\text{C}_q\text{F}_{2q+1})$ is SO_2F , which is not a common leaving group. Note F is a leaving group not SO_2F . Specification is not adequately enabled as to how to make compounds of formula (I) wherein the said A or Z is SO_2F group. Prior art search in the related area also does not show viability of displacement of SO_2F group.

2. The predictability or lack thereof in the art:

Hence the process as applied to the above-mentioned compounds claimed by the applicant is not an art-recognized process and hence there should be adequate enabling disclosure in the specification with working example(s).

4. The amount of direction or guidance present:

Examples illustrated in the experimental section or written description offer no guidance or teachings as to how perform the process of making compound of formula I wherein the said A or Z is SO_2F group.

5. The presence or absence of working examples:

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Although examples in the specification show process for making compound of formula I, they are limited to known reaction wherein displacement of halogen or fluorinated alkylsulfonate. There are no representative examples showing the viability of the process for the process of making compound of formula I wherein the said A or Z is SO_2F group embraced in the instant claims.

6. The breadth of the claims:

Specification has no support, as noted above, for the said process of making generically embraced in the claim language would lead to desired compound of formula I and there is also no valid chemical reasoning for one trained in the art to expect that said functional group would be reactive and lead to the coupling product of formula II with formula III.

7. The quantity of experimentation needed:

The quantity of experimentation needed would be an undue burden on skilled art in the chemical art since there is inadequate guidance given to the skilled artisan for the many reasons stated above. Even with the undue burden of experimentation, there is no guarantee that one would get the product of desired structure, namely compound of formula I embraced in the instant claims in view of the prior art teachings.

Thus, factors such as "sufficient working examples", the "level of skill in the art and predictability, etc. have been demonstrated to be sufficiently lacking in the case for the instant claims.

Applicants' argument to overcome this rejection is not persuasive. The references cited does not show the OSO_2F as whole is a leaving group. Hence this rejection is proper

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and is maintained.

Allowable Subject Matter

Claims 34-35, 37, 40, 45-49, 52, and 55-67, barring finding of any prior art in a subsequent search, allowed. Said claims would be allowed since specific genus/species or composition or the method of use embraced in these claims are not taught or suggested by the art of record or from a search in the relevant art area.

Conclusion

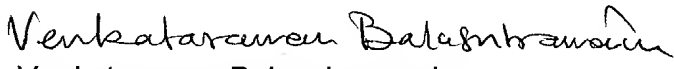
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (571) 272-0674. If Applicants are unable to reach Mukund Shah within 24-hour period, they may contact James O. Wilson, Acting-SPE of art unit 1624 at 571-272-0661.

The fax phone number for the organization where this application or proceeding is assigned (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.


Venkataraman Balasubramanian

7/9/2004